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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,830	08/29/2003	Hisashi Tsubata	Q77026	8024

23373 7590 06/02/2004
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EXAMINER

UHLIR, NIKOLAS J

ART UNIT PAPER NUMBER

1773

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,830

Applicant(s)

TSUBATA ET AL.

Examiner

Nikolas J. Uhler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/051,015.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/23/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

1. This office action supercedes the previous office action dated 05/11/2004. The preliminary amendment dated 08/29/2003 has been entered. Currently, claims 13-16 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. First, there is no antecedent basis for "the protrusion portions" required by claims 13-16. Claims 13-16 require the master to have an "uneven surface prior to the requirement of protrusion portions. However, an uneven surface can simply mean a surface that is not perfectly flat, and does not require the surface ot have "protrusion" portions. Correction is required.

4. Further, the applicant requires the magnetic master medium to be "used" after the surface of the protrusion portions have been ground (claims 13-14), or "reused" after the protrusion portions have been ground. Though the examiner acknowledges that the applicant likely means that the master has been used to record information on a slave medium, the claim language is much broader than this particular use. Thus, it is unclear to the examiner exactly what constitutes a "use" or "reuse" of the master. Clarification is requested.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagao et al. (JP publication #2000-331341).

7. For the purpose of this examination the examiner has relied on a machine translation of JP2000-331341 to provide the basis for this rejection. A copy of this translation and the original Japanese accompanies this office action. All references in this office action refer to the machine translation unless otherwise expressly noted.

8. The examiner notes that the terms "use" and "reuse" are very broad, and do not require the magnetic master to be used to record information on a slave medium. Thus, a magnetic master which has been "used" in **any** manner reads on the instant claims.

9. Bearing the above interpretation in mind, Nagao anticipates all of the instant claim limitations. Specifically, Nagao teaches a method for forming a magnetic master medium wherein the surface of the master medium is ground after a magnetic layer having an uneven surface is formed (see sections 20-22, specifically lines 1-8 of section 22). Though Nagao does not teach that this particular master medium has an "uneven surface" as required by the instant claims, the examiner takes the position that every surface has a surface roughness to some degree. Thus, the claimed "uneven surface" requirement is met.

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10. Regarding the grinding step. The specific sections of Nagao cited above clearly teach grinding the surface of the master prior to using it as a master information carrier. Thus, the limitations of claim 13 are met.

11. Regarding the limitations of claim 14. Nagao teaches that the grinding step is performed to remove burrs from the surface of the master. This reads on the applicant's claimed "ground according to the degree to which said surface is marred."

12. Regarding the limitations of claims 15 and 16. These limitations are met as set forth above for claims 13-14. The master medium of Nagao is used in a photolithography apparatus when the patterned magnetic layer is formed on the surface. After magnetic layer is formed the, master is then ground (equivalent to applicant's claimed grinding step), and then "reused" as a magnetic master medium.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 571-272-1517. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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